

REMARKS

Claims 1-28 and 33-50 are all the claims presently pending in the application. Claim 7 has been amended to correct a minor typographical error. Claims 47-50 have been added to claim additional limitations of the claimed invention.

It is noted that the claims have been amended solely to more particularly point out Applicant's invention for the Examiner, and not for distinguishing over the prior art, narrowing the claim in view of the prior art, or for statutory requirements directed to patentability.

It is further noted that, notwithstanding any claim amendments made herein, Applicant's intent is to encompass equivalents of all claim elements, even if amended herein or later during prosecution.

Applicant gratefully acknowledges that claims 24-28 and 33 are allowed and claims 6-13 would be allowable if rewritten in independent form. However, Applicant respectfully submits that all of the claims are allowable.

Claims 1-5, 14-18, 19-23 and 34-46 stand rejected under 35 U.S.C. §103(a) as being unpatentable over Muto Akihiro (JP 10-074221) in view of Asad et al (U.S. Patent No. 6,539,093). Claims 41, 42 and 44-46 stand rejected under 35 U.S.C. §103(a) as being unpatentable over Akihiro in view of Henley (U. S. Patent Publication No. 2002/0065758) further in view of Asad. Claims 1-5, 14-23 and 34-46 stand rejected under 35 U.S.C. §103(a) as being unpatentable over Okumura et al. (JP 10-021302) in view of Ensor et al (U.S. Patent No. 5,721,780).

These rejections are respectfully traversed in view of the following discussion.

I. THE CLAIMED INVENTION

The claimed invention (e.g., as recited in claim 1) is directed to a method of conducting business electronically between a first party and a second party. The method includes providing an intermediary relationship with a third party who knows an identity of the first party but no privacy-compromising information regarding a proposed electronic business transaction between the first and second parties, and conducting the electronic business transaction between the first and second parties through the third party such that the identity of the first party is kept from the second party. Further, the second party is provided with information identifying the first party only as a transactional party in the electronic business transaction, and

Importantly, providing the intermediary relationship with the third party includes replacing (e.g., by the third party) identification data of the first party with an identifier in a document which is transmitted to the second part (Application at page 8, line 15-page 9, line 3; Figure 3).

In conventional methods of conducting electronic business, a customer (e.g., first party) may complete a form (e.g., an electronic version of an insurance application form) with the customer's identification data (e.g., name, data of birth, medical information, etc.) and forward the completed application to a service provider (e.g., second party). However, the development of information technology (IT) such as data mining, has allowed businesses to use data such as the customer's identification data to acquire more information regarding the customer than customer would prefer to disclose (Application at page 2, line 5-page 3, line 6).

The claimed invention, on the other hand, provides a method of conducting business electronically between two parties which includes providing an intermediary relationship with a third party which includes replacing (e.g., by the third party) identification data of the first party with an identifier in a document which is transmitted to the second part (Application at page 8, line 15-page 9, line 3; Figure 3). The third party may then forward the document (e.g., in which the first party's identification data has been replaced) to the second party. This may allow the transaction to be conducted without the second party ever learning the identity of the first party.

II. THE ALLEGED PRIOR ART REFERENCES

A. Akahiro, Asad, Muto and Henley

The Examiner alleges that Akahiro would have been combined with Asad to form the invention of claims 1-5, 14-18, 19-23 and 34-46, and that Akahiro would have been combined with Henley and Asad to form the invention of claims 41, 42 and 44-46. Applicant respectfully submits, however, that these references would not have been combined as alleged by the Examiner and even if combined, the alleged combination would not teach or suggest each and every element of the claimed invention.

In the interest of expediting prosecution, Applicant would again point out to the Examiner that the Asad patent et al. (U.S. Patent No. 6,539,093) is commonly assigned with the present Application (see Assignment Recorded in the Present Application at Reel/Frame 010829/0371).

Therefore, since the Asad Patent is at best a 35 U.S.C. §102(e) reference, pursuant to 35 U.S.C. §103(c), the Asad Patent cannot be used to reject the present Application under 35 U.S.C. §103(a). That is, the Asad Patent is not prior art against the present Application.

Applicant notes that the Examiner acknowledges that Asad is not prior art against the claimed invention on page 7 of the Office Action.

In view of the foregoing, the Examiner is respectfully requested to withdraw this rejection.

B. Okumura and Ensor

The Examiner alleges that Okumura would have been combined with Ensor to form the invention of claims 1-5, 14-23 and 34-46. Applicant submits, however, that these alleged references would not have been combined and even if combined, the alleged combination would not teach or suggest each and every element of the claimed invention.

Applicant respectfully submits that these references are completely unrelated and would not have been combined as alleged by the Examiner. Indeed, Okumura is directed to a system which allegedly enables a service provider to acquire information such as age, income, carrier, etc. stored in a third person while guaranteeing anonymity of a user (Okumura at Abstract), whereas Ensor is directed to a method of determining whether access to a network is authorized (Ensor at col. 7, lines 2-4). Thus, no person of ordinary skill in the art would have considered combining these disparate references, absent impermissible hindsight.

Further, Applicant submits that there is no motivation or suggestion in the references to urge the combination as alleged by the Examiner. Indeed, these references clearly do not teach or suggest their combination. Therefore, Applicant respectfully submits that one of ordinary skill in the art would not have been so motivated to combine the references as alleged by the Examiner. Therefore, the Examiner has failed to make a prima facie case of obviousness.

Moreover, neither Okumura, nor Ensor, nor any alleged combination thereof teaches or suggests "*wherein said providing said intermediary relationship with said third party comprises replacing identification data of said first party with an identifier in a document which is transmitted to said second part*", as recited, for example, in claim 1 and similarly recited in claims 2, 24, 34-39 and 41.). The third party may then forward the document (e.g., in which the

first party's identification data has been replaced) to the second party. This may allow the transaction to be conducted without the second party ever learning the identity of the first party.

For example, as illustrated in Figure 3, when the third party 120 receives the application A from a first party 100, the third party 120 may cut off the header H 210 and replace it with a number, before sending the application A to the second party 110 (Application at page 19, lines 5-8). Thus, the second party 110 may receive the application A with an identifier in place of the identification data.

Clearly, this is not taught or suggested by the cited references. Indeed, the Examiner expressly concedes that this feature is not taught or suggested by Okumura, but alleges that the feature is disclosed by Ensor. The Examiner is clearly incorrect.

First, Applicant would point out that Ensor is completely unrelated to the claimed invention. Indeed, as noted above, Ensor is directed to a method of determining whether access to a network is authorized, which is not necessarily related to a method of conducting electronic business.

Further, Applicant would point out that the claimed invention involves replacing (e.g., by the third party) first party identification data **in a document** with an identifier, and transmitting the document (e.g., transmitting, by the third party, the document with the identification data replaced by the identifier) to the second party. Ensor, on the other hand, is completely unrelated to replacing identification data **in a document**.

Indeed, the Examiner attempts to rely on col. 6, lines 26-45 in Ensor to support his allegations. However, nowhere in this passage or anywhere else, does Ensor teach or suggest replacing (e.g., by the third party) first party identification data **in a document** with an identifier. In fact, this passage in Ensor merely discloses a process in a network control center 108, 206 for automatically changing the passwords stored within the memory 126 of the user terminals 110, 202, and updating the corresponding list of passwords stored in the control center's internal database 112 (Ensor at col. 6, lines 26-34).

First, nowhere does this passage even disclose a "document" (e.g., an insurance application that is completed by a customer) as in the claimed invention. Indeed, the "password" being changed is only "stored within the memory 126" and is not contained in any document.

Second, the passage does not even disclose "identification data" (e.g., name, address, medical history, etc.). Instead, Ensor merely discloses changing a password with another password. Applicant would point out that **the second passwords is no less revealing of a user's identity than the first password**. That is, Ensor does not replace a password with an identifier which may be used, for example, to prevent a second party from learning of the first parties identity. That is, the function of the second password is completely unrelated to the function of the "identifier" in the claimed invention. Indeed, Ensor does not even contemplate this underlying concept of the claimed invention.

Therefore, Ensor certainly does not teach or suggest replacing (e.g., by the third party) first party identification data **in a document** with an identifier, and transmitting the document (e.g., transmitting, by the third party, the document with the identification data replaced by the identifier) to the second party.

Therefore, Applicant submits that these references would not have been combined and even if combined, the combination would not teach or suggest each and every element of the claimed invention. Therefore, the Examiner is respectfully requested to withdraw this rejection.

III. FORMAL MATTERS AND CONCLUSION

In view of the foregoing, Applicant submits that claims 1-28 and 33-50, all the claims presently pending in the application, are patentably distinct over the prior art of record and are in condition for allowance. The Examiner is respectfully requested to pass the above application to issue at the earliest possible time.

Should the Examiner find the application to be other than in condition for allowance, the Examiner is requested to contact the undersigned at the local telephone number listed below to discuss any other changes deemed necessary in a telephonic or personal interview.

The Commissioner is hereby authorized to charge any deficiency in fees or to credit any overpayment in fees to Assignee's Deposit Account No. 50-0510.

Respectfully Submitted,



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